REMARKS

Claims 1 through 24 are pending in this application. Claims 3 and 8 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claim 24 has been newly added.

I. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 1 through 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sakurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630) and further in view of Choi (U.S. Patent No. 5,648,781). The Applicant respectfully traverses.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

> To establish a *prima facie* case of obviousness, three basic criteria
> must be met. First, there must be some suggestion or motivation,
> either in the references themselves or in the knowledge generally
> available to one of ordinary skill in the art, to modify the reference or
> to combine reference teachings. Second, there must be a reasonable
> expectation of success. Finally, the prior art reference (or references

when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art

and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20

USPQ2d 1438 (Fed. Cir. 1991).

1. The combination of references fails to teach or suggest a displayed indicator that makes

both a selection of a menu item and then the indicator that is used to select the menu has its position

automatically adjusted to be within the submenu when the submenu is displayed as seen in claim 1

for example. The combination also fails to teach or suggest the displayed indicator moving back to

the menu item when the sub menu is erased.

The indicator in Sakurai is not used for selecting an item of a menu but is an <u>internal pointer</u>

that has its value automatically increased or decreased by a management program.

The Examiner points to col. 9, lines 47-57 of Sakurai as disclosing an area indicator which

is increased or decreased by one for a display of submenu and for a display of a previous menu. Col.

9, lines 47-57 refers to figure 13A. As seen in col. 5, lines 22-23, in the description of figure 13A

"figures 13A to 13D are illustrative drawings of a **display-file-name storage area for storing a**

menu history."

The area indicator is not being used to select a menu item and it is not displayed to a user for

selection of the menu. The figures 13A-13D and the description in col. 9, lines 47-57 is dealing with

the storage area and clearly, the area indicator of Sakurai is only an internal pointer that only

concerns the internal workings of Sakurai. On the other hand as seen in claim 1 for example of the present invention, the indicator is displayed and is used to select.

Sakurai also does not teach or suggest the displayed indicator which is used to select, also adjusting to the position of the submenu when the submenu is chosen. An "area indicator is incremented by one each time a new submenu is dispayed" (col. 9, lines 50-51) is not teaching or suggesting *adjusting the position of said indicator to be located within said sub menu*. Clearly the description in col. 9, lines 50-51 is the language describing an internal pointer in a storage level system. The internal pointer of Sakurai is not physically shown to be moving to the new submenu. There, then Sakurai also does not teach the relocation of the displayed indicator back to the menu item when the submenu is erased.

Miyashita and Choi add nothing further to the combination. Miyashita and Choi both show a cursor but neither Miyashita or Choi make any teaching or suggestion of an indicator that is displayed and used to select and is moved to a position of the submenu when an item of relating to the submenu is selected by the indicator and moves back to the menu item when the submenu is erased.

2. Sakurai is teaching away from the present invention.

In col. 9, lines 58-60, Sakurai states, "At the step S3, a selection can be made by using such keys as function keys in order to control the pages of the menu on a screen, display a HELP menu, etc." This is the only section of Sakurai which describes how the menu items are selected. This not only shows that a displayed indicator is not used to "select" the menu items, but that Sakurai teaches

away from the use of an indicator for selection purposes by using a key such as function keys which are usually like F1, F2 on a keyboard for instance. Therefore, if F1 is selected, then the help menu item is selected. A visual indicator is not manipulated, but actually function keys are used to <u>control the pages of the menu</u> in Sakurai.

According to MPEP §2145, "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). This portion of Sakurai cannot be just ignored because according to MPEP §2141.02, "A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)."

Sakurai further teaches away from the present invention that includes *moving said indicator within said screen* as mentioned in claim 3 of the present invention. The structure of Sakurai limits any kind of indicator (although Sakurai lacks a displayed indicator as shown above) to only the menu since the indicator shown is only an internal pointer and not actually displayed. The present invention on the other hand in claim 3 for instance allows the indicator to move within the screen. The menu management system of Sakurai, therefore, would teach away from allowing an indicator that can move within a screen.

3. As seen for example in claim 4, the combination of references fail to teach or suggest

storing a location of said menu item in reference to said menu area with regard to *making a selection*

of a menu item displayed within said display screen by moving said indicator around said menu to

said menu item and similarly pointed out in claim 8 (*storing a location of said menu item which was*

selected) of the present invention for example.

In paper number 20, the Examiner stated that Choi teaches of a menu storage unit (70). However, looking at Choi, in col. 4, lines 28-29, it states "Here, menu display storage unit 70 also stores the sub-menus and control mode displays as well." The storage unit 70 is not described to store the location of the menu item with regard to the selection of the menu item as mentioned in claim 8 for example but just as mentioned in col. 4, lines 28-29 storing sub-menus. The claims must be looked as a whole and not as isolated section without regard to the remainder.

Further, in claim 17 of Sukurai '685, it states "a memory storing said menu display definition files each corresponding to one of said menu displays, each of said menu display definition files comprising definitions of items displayed on said corresponding one of said menu displays and definitions of said processes each carried out upon selection of a corresponding one of said items. In col. 10, lines 11-16 of Sukurai '685, it states "If a selection is made for return to a previous display at this point, a menu display corresponding to the file name #1.TBL stored in the area 2 is displayed. Since the current hierarchy level has returned to the second level, an area which stores a file name at the time of displaying a next submenu is the area 3, again" In col. 9, lines 44-46 of Sukurai '685 states "At the same time, the file name of the submenu is stored in a display-file-name storage area allocated in a memory." Throughout Sukaurai '685 one can see that there is no mention of storing the menu item location according to the menu area as seen in the present invention but more with

file names as mentioned above, "file name of the submenu is stored." Sukaurai is dealing more with menu hierarchy as using file definitions and menu file names and not actual menu area. Miyashita fails to mention anything further, and therefore, the combination fails to teach or suggest the claimed element.

Further, the added claim 24 which is supported by the original claim 1, mentions the storing of a location of the selected menu item within the display screen. The above mentioned combination of references also do not teach or suggest the storing of a location within the screen. Sakurai for instance only mentions the movement of the depth direction of the hierarchy being stored in a display-file-name storage area which has no concern with a screen display (col. 9, lines 56-57) but fails to mention and relation to the display screen. Further, the depth direction is stored but not the location and not the location within the screen.

II. IDS PTO-1449

As the Applicant mentioned in his previous response (paper number 19) filed on 14 November 2002, the Applicant would like to note again that the PTO-1449 form from the IDS filed . on 1 April 2002 still has not been returned acknowledging the consideration of the enclosed five (5) documents in the IDS.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the

examiner is asked to contact the applicant's attorney.

A fee of $18.00 is incurred by the addition of one (1) claim above 23. Applicant's check

drawn to the order of Commissioner accompanies this Amendment. Should the check become lost,

be deficient in payment, or should other fees be incurred, the Commissioner is authorized to charge

Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

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